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**From:** Chris Maiorana
**Sent:** Monday, June 06, 2005 2:02 PM
**To:** AB85 Comments
**Subject:** comments on proposed changes to 37 CFR part 1

Dear Sirs,

I am writing to express my concern under the proposed changes to 37 CFR §1.11. While the change to remove "abandoned" before "published applications" appears minor, it solidifies a position held by the Patent Office in recent years that the act of publication at 18 months constitutes an inherent power to inspect. This inherent power to inspect has been magnified over the past 12 months by the Patent Office's image file wrapper system available on PAIR. The Patent Office's current practice that once a patent application has been published that the complete file history, starting from the initial filing papers, will be available to anyone with Internet access (i.e., most of the world). In a recent conversation with the legal department at the Patent Office, I inquired where the authority to open files to the public based on publication, is found. I was pointed to 37 CFR §1.14. Interestingly enough, the section is entitled Patent Applications Preserved in Confidence. However, it is becoming more and more clear that very little in a patent application file wrapper is being kept in confidence. In particular, unless a request for non-publication is filed, every patent application filed with be published at 18 months. At this point, the patent application will no longer be preserved in confidence.

In explaining the regulations permitting such publication, the inherent conflict within 37 CFR §1.14(a)(1)(iii) is glaringly apparent. In particular, the first part of this subsection states that a copy of the application as filed, the file contents of the application, or a specific document in the file of a pending application that has been published as a patent application publication may be provided to any person upon request, and payment of the appropriate fees set forth in §1.19(b). The Patent Office takes the position that this section, in combination with §1.14(b) allows full electronic access to a patent application. Section 1.14(b) states that where a copy of the application papers or access to the application may be made available pursuant to paragraphs (a)(1)(i) through (a)(1)(vi) of this section, the Office may at its discretion provide access to only an electronic copy of the specification, drawings and file contents of the application. The Patent Office takes the position that this electronic access obviates the need for the appropriate fee mentioned in this section. However, the Patent Office was asked to reconcile this section with the end of 37 CFR §1.14(a)(1)(iii) that states the Office will not provide access to the paper file of a pending application that has been published, except as provided in paragraph (c) or (h) of this section. The only explanation provided that the end of this section applies only to the paper file, and not to electronic access. On the one hand, paper access and electronic access are considered synomous. On the other hand they are not. An alternate interpretation would be that if the Office will not provide access to the paper file of such an application, section (b) would also prohibit access electronically. The subsections (c) or (h) provide are consistent with traditional access to files. For example, section (c) provides access through a power to inspect. Section (h) provides access through the need of an act of Congress. A power to inspect by the applicant, or an act of Congress would be traditional requisites for allowing access to patent applications that were otherwise preserved in confidence. Why would a power to inspect be needed to access a paper file, but not an electronic file?

Several other practitioners have been contacted regarding this issue. Various concerns were raised. One concern was that electronic access has been provided to the scans of the signatures from the original filing papers, based on publication. While these documents have been previously available in the file history, the file histories were not available, at no cost, via the Internet. The Patent Office's practices appear to make it easier to participate in identity theft. Even if patent application papers were not available after publication, one would expect them to eventually be available to the public if the patent application eventually issues as a patent. Therefore, this issue goes to the deeper concern of whether certain portions of the file history should be redacted prior to being available on the PAIR system. It appears reasonable to redact inventor signatures on the filing papers, but to make them available via petition, and conventional

procedures as has been done in the past. For example, in a situation where the authenticity of the signature is in questions, the papers would be available to such parties having an interest in the authenticity. This would prevent wholesale use of an inventors signature in an identity theft situation.

Another area of concern is at the fundamental level of making additional technical information available to competitors before it was previously available. While the published patent application does provide the specification and the claims, it does not provide insight into the prosecution history of a patent application. Such a file history was conventionally preserved in confidence (thus the title of 37 C.F.R. §1.14) until the patent issued. Since no right to exclude is granted prior to the application being issued, it follows that no access to the file history should be provided either.

When questioned on why the Patent Office took the position of publishing more than the application as filed, the Patent Office's position is that full access to the entire file history more than satisfies the 18 month publication provision as provided by Congress. While this is true, no authority has been provided as to why the Patent Office has decided to provide more information than was provided for by Congress.

Furthermore, the Patent Office expressed alternatives to having a file open to the public. The first alternative was to simply request non-publication. Although this is not possible in an application that is to be filed in a foreign country, this was the suggestion. Next, the Patent Office suggested pursuing trade secret routes. Simply not filing patent applications, does not appear to be a reasonable response to what appears to be an overstepping of authority by the Patent Office.

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